

REMARKS

Claims 1-19, 21-39, 41, and 42 are currently pending in the present application. The Applicant respectfully requests reconsideration of the present application in view of the Applicant's comments below.

Rejections under 35 U.S.C. § 103(a)

WCL Reference is not Prior Art

Claims 1-19, 21-39, 41, and 42 were rejected under 35 U.S.C. §103(a) as being anticipated by International Application No. PCT/FI99/01025 to Wireless Commerce Ltd. ("WCL"), published as WO 00/22907. The Applicant respectfully submits, however, that this reference is not prior art with respect to the present application.

The Office Action does not indicate the basis on which the WCL reference would qualify as prior art under 35 U.S.C. §102. Since the WCL reference is a printed patent publication, however, the Applicant is assuming for purposes of the present response that the asserted basis for prior art status would be 35 U.S.C. §102(b) or 35 U.S.C. §102(e).

With respect to 35 U.S.C. §102(b), the present application is not prior art in view of the priority date of parent patent application 09/511,650, which was filed on Feb. 22, 2000. The WCL reference was published after this date, on April 27, 2000.

With respect to 35 U.S.C. §102(e), references based on international applications that were filed prior to November 29, 2000 are subject to the former (pre-AIPA) version of 35 U.S.C. §102(e). This version is as follows:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Under the version of §102(e) applicable to the WCL reference, which is an international application, such a reference is only prior art under §102(e) if it meets one of the following criteria:

- a. it resulted in a granted U.S. patent; or
- b. it is “an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title” before the invention by the present Applicant.

The Applicant has not been able to identify a granted U.S. patent based on this international application, and no such patent has been identified in the Office Action. Therefore, no basis for establishing that this reference is prior art under the first section of §102(e) has been provided. If the Examiner provides such basis in a subsequent Office Action, the Applicant reserves the right to respond to such new information.

A search of the WIPO database (see:

http://www.wipo.int/pctdb/en/fetch.jsp?DISP=25&IDB=0&SORT=1208071-KEY&LANG=ENG&LANGUAGE=ENG&SERVER_TYPE=19&FORM=SEP-0%2FHITNUM%2CB-ENG%2CDP%2CMC%2CAN%2CPA%2CABSUM-ENG&IA=FII999001025&TOTAL=1&C=00&SEARCH_IA=FII999001025&START=1&QUERY=PCT%2FFI99%2F01025&DBSELECT=PCT&TYPE_FIELD=256&RESULT=1&IDOC=317083&DISPLAY=NATIONAL) indicates that this International

Application entered the national phase in the U.S. on November 22, 2002. The date on which the WCL application appears to have fulfilled the requirements of paragraphs (1), (2), and (4) of 35 U.S.C. §371(c) therefore appears to be November 22, 2002, which is subsequent to the priority date of the present application.

In view of the foregoing, no basis has been presented for establishing that the WCL reference is prior art with respect to the present application. The Applicant therefore respectfully requests that the rejection of claims 1-19, 21-39, 41, and 42 under 35 U.S.C. §103(a) in view of the WCL reference be withdrawn as being moot, and that the WCL reference not be cited as the basis for rejecting the presently pending claims unless it can be shown that this reference is prior art.

Requirements of 37 CFR §1.104 have not been Met

If the WCL reference is established as being prior art, the Applicant respectfully submits that an appropriate basis for the rejection contained in the Office Action has not been provided. The Office Action references “column 6, lines 19-51” of WCL. However, the WCL reference is not divided into columns (only pages), and if page 6 was intended, this page ends on line 37. Lines 19-37 of page 6 of the WCL reference do not, in any case, support the proposition for which this passage is cited, namely the disclosure of “a coordinator ... that receives a first purchase order from the buyer,” referring only to a “purchase offer,” i.e. an auction bid.

The Applicant therefore respectfully submits that the citation of column 6, lines 19-51 of the WCL reference does not comply with the requirements of 37 CFR §1.104, in particular the requirement that “the particular part [of a reference] relied on must be designated as nearly as practicable.” In view of this, the Applicant respectfully requests that an appropriate citation of the WCL reference be provided so that the Applicant can be afforded the opportunity to respond to such citation.

Pending Claims are Patentable over WCL

Even if the WCL reference is established as being prior art with respect to the present application, the pending claims are not made obvious by this reference. On page 2 of the Office Action, portions of the WCL reference on page 1, page 8, and the claims are said to disclose a coordinator that issues a second purchase order to a seller based on a first purchase order from a buyer, and that assumes title in an invoice. The cited passages do not disclose this aspect of the present invention, however. The passage on page 1 states that an auction management system can “process” a buying offer in order to match it with a seller. The auction management system however does not take title to anything of the buyer or seller in this transaction, and the “legally binding contract” referred to in this passage is exclusively between the buyer and the seller (page 1, lines 28-29). Likewise, the claims refer only to transferring information about a purchase offer to a seller (see, e.g., claim 1), and do not disclose that a coordinator of a transaction

should take title to an invoice of the seller. Page 8 refers only to the use of the internet for an auction.

In view of the lack of support provided by the WCL reference for the present rejection under 35 U.S.C. §103(a), the Applicant has not commented herein on the applicability (or lack thereof) of any comments in the present specification to a rejection based on the WCL reference. The Applicant does, however, reserve the right to so comment if an appropriate basis for the present rejection is provided.

In view of the foregoing, the Applicant respectfully requests that the rejection of claims 1-19, 21-39, 41, and 42 under 35 U.S.C. §103(a) in view of the WCL reference and the Applicant's specification be withdrawn.

Conclusion

The Applicant believes that all pending claims, claims 1-19, 21-39, 41, and 42, are in condition for allowance, and a Notice of Allowance is respectfully requested. If, however, there remain any issues which can be addressed by telephone, the Examiner is encouraged to contact the undersigned at the telephone number listed below.

No fees are believed to be due in connection with this communication. However, if any fees are found to be due, please charge such fees, or credit any overpayment, to Deposit Account No. 19-2090.

Respectfully submitted,

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Date: August 7, 2008

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